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REMARKS

In the Office Action, the Examiner restricted claims 29-31, and rejected claims 5-8, 15 and 17-28 under 35 USC §103(a). The rejection of these claims is fully traversed below.

Claims 15, 24 and 27 have been amended to further clarify the subject matter regarded as the invention. Claims 25 and 29-31 have been cancelled without prejudice or disclaimer. Further, new claims 32-38 have been added.

Claims 5-8, 15 and 17-24, 26-28 and 32-38 are pending in the application. Reconsideration of the application is respectfully requested based on the following remarks.

RESTRICTION REQUIREMENT

In the Office Action, the Examiner required restriction of claims 29-31 as being an independent or distinct invention. As such, the Examiner withdrew claims 29-31 from the application.

PATENTABILITY OF CLAIMS

In the Office Action, the Examiner rejected claims 5, 6, 15, 17, 18, 21-26 and 28 under 35 U.S.C. § 103(a) as unpatentable over Swab et al., U.S. Patent No. 6,929,365, in view of Horiguchi, U.S. Patent No. 7,031,667; rejected claim 7 under 35 U.S.C. § 103(a) as unpatentable over Swab et al. in view of Horiguchi and further in view of Wareen, U.S. Patent No. 7,013,009; rejected claim 8 under 35 U.S.C. § 103(a) as unpatentable over Swab et al. in view of Horiguchi and further in view of Jesiek, U.S. Patent No. 6,010,216; and rejected claims 19, 20 and 27 under 35 U.S.C. § 103(a) as unpatentable over Swab et al. in view of Horiguchi and further in view of Spitzer, U.S. Patent No. 6,091,546. These rejections are fully traversed below.

*PATENT*Claim 15 and its dependent claims

Claim 15 pertains to a pair of eyeglasses that includes a frame having a pair of arms, with wireless communication circuitry provided within the internal area of one or both of the arms. In rejecting claim 15, the Examiner relies on a combination of Swab et al. in view of Horiguchi. Among other things, claim 15 recites "at least one operation indicator configured to indicate an operation of said wireless communication circuitry...." Further claim 15 recites:

wherein said at least one operation indicator is at least partially internal to said frame,

wherein said at least one operation indicator is controlled based on a monitored operational condition of said wireless communication circuitry, and

wherein said at least one operation indicator being configured to indicate when said wireless communication circuitry is in use.

On page 3 of the Office Action, the Examiner admits that Swab et al. does not disclose such an operation indicator or its use. In view of this deficiency, the Examiner combines Horiguchi with Swab et al. in order to reject claim 15.

Applicants disagree that the use of Horiguchi in any way overcomes the deficiencies of Swab et al. Horiguchi pertains to a portable telephone, **not a pair of eyeglasses**. Given the distinct nature of these products, there would be no motivation for one skilled in the art to combine the portable telephone of Horiguchi with the eyeglasses of Swab et al.

Further, even if Horiguchi is somehow combinable with Swab et al. the noncommunicative mode indicating lamp 1 of Horiguchi illuminates when the portable telephone is functioning in a noncommunicative mode (i.e., not communicating). Indeed, the expressed objective of Horiguchi is to notify persons around a user of the portable telephone that the portable telephone is functioning in the noncommunicative mode. Horiguchi, col. 3, lines 23-27. In contrast, the operation indicator as recited in claim 15 indicates operation of the wireless communication circuitry provided within the frame of the eyeglasses.

PATENT

Furthermore, it should also be noted that claim 15 recites "said at least one operation indicator being configured to indicate when said wireless communication circuitry is in use." Thus, if anything, the noncommunicative mode indicating lamp 1 of Horiguchi teaches away from indicating operation of wireless communication circuitry as recited in claim 15.

In Horiguchi, the setting of either the communicative mode or the non-communicative mode is determined by an interchanging key 6. See Abstract. "[W]hen a interchanging key 6 is pushed down, the noncommunicative mode-indicating lamp 1 lights up, and notif[ies] the user and the persons around him that the portable telephone is functioning in the noncommunicative mode...." Horiguchi, col. 5, lines 54-56. Horiguchi does not teach or suggest any sort of monitoring activity of its portable telephone for use in controlling an operation indicator. If anything, the user action --pressing of the interchanging key 6--, required by Horiguchi to switch modes would *teach* away from monitoring an operational condition of wireless communication circuitry to control the operation indicator.

Still further, the operation indicator recited in claim 15 is part of an eyeglass frame, not a conventional portable telephone as in Horiguchi. In particular, claim 15 recites "wherein said at least one operation indicator is at least partially internal to said frame." The noncommunicative mode indicating lamp 1 of Horiguchi is not taught or suggested as being anyway useful or applicable on a pair of eyeglasses, let alone at least partially internal to a frame for eyeglasses as recited in claim 15.

Thus, Horiguchi fails to overcome the deficiencies of Swab et al. Accordingly, it is submitted that claim 15 is patentably distinct from any combination of Swab et al. in view of Horiguchi. Additional limitations recited in independent claim 15, or its dependent claims, are not further discussed as the above-discussed limitations are clearly sufficient to distinguish the claimed invention from Swab et al. in view of Horiguchi. For example, claim 5 further recites that the eyeglasses are such that "said at least one speaker is provided

PATENT

completely within the internal area of at least one of said two arms" and "said at least one speaker is not visible when provided within the internal area of at least one of said two arms." The Examiner references Figure 8 and col. 7, lines 11-23 of Swab et al. as being relevant. However, Figure 8 of Swab et al. clearly illustrates the speakers as not within an internal area of an arm (e.g., temple), and nothing disclosed therein suggests that the speakers would not in all cases remain visible. Also, claim 6 recites: "wherein said at least one speaker is internal to the rear portion of said arm, and wherein the rear portion of said arm does not include any visually perceptible openings for said at least one speaker." Nothing in Swab et al. or Horiguchi teaches or suggests providing a speaker in a rear portion of an eyeglass arm such that the arm does not include any visually perceptible openings for the at least one speaker. Still further, claim 8 recites that the eyeglasses include "a power adapter connector to facilitate charging said at least one battery." On page 7 the Examiner argues that because Jesiek uses rechargeable batteries claim 8 is obvious. Applicants disagree. Swab et al., Horiguchi and Jesiek, alone or in combination, fail to teach or suggest providing eyeglasses with a power adapter connector.

Claim 24 and its dependent claims

Claim 24 pertains to a method for operating a pair of eyeglasses having wireless communication circuitry and an operation indicator. The method recites:

monitoring the wireless communication circuitry to determine an operational condition of the wireless communication circuitry;
and

controlling the operation indicator based on the operational condition of the wireless communication circuitry as determined by said monitoring,

wherein the operational condition indicates at least whether the wireless communication circuitry is in use.

On pages 6-7 of the Office Action, the Examiner admits that Swab et al. fails to disclose various aspects of claim 24. However, the Examiner relies on Horiguchi to overcome these deficiencies.

PATENT

As noted above, in Horiguchi a user is required to push an interchanging key 6 to cause a noncommunicative mode-indicating lamp 1 to light up. Consequently, Horiguchi does not teach or suggest in any way the monitoring of an operational condition of wireless communication circuitry for use in controlling an operation indicator. Nor does Horiguchi teach or suggest any capability to control an operation indicator based on the operational condition determined by the monitoring.

Accordingly, it is submitted that claim 24 is patentably distinct from the combination of Swab et al. in view of Horiguchi. Additional limitations recited in independent claim 24, or its dependent claims, are not further discussed as the above-discussed limitations are clearly sufficient to distinguish the claimed invention from Swab et al. in view of Horiguchi.

Thus, it is respectfully requested that the Examiner withdraw the rejection of claims 5-8, 15 and 17-28 under 35 U.S.C. § 103(a).

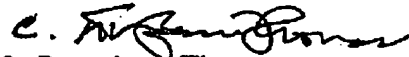
PATENT**SUMMARY**

It is submitted that the rejections under 35 U.S.C. § 103(a) have been traversed. Reconsideration of the application and an early Notice of Allowance are earnestly solicited.

If there are any issues remaining which the Examiner believes could be resolved through either a Supplemental Response or an Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned representative at the telephone number listed below.

Applicants hereby petition for an extension of time which may be required to maintain the pendency of this case, and any required fee for such extension or any further fee required in connection with the filing of this Amendment is to be charged to Deposit Account No. 50-3894.

Respectfully submitted,



C. Douglass Thomas
Reg. No. 32,947

(650) 903-9200 x103